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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,807	09/23/2003	Robert E. Hanes JR.	2002-IP-008967U1	1954

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EXAMINER	
WALKER, ZAKIYA NICOLE	
ART UNIT	**PAPER NUMBER**
3676	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,807	HANES, ROBERT E.	
	Examiner	Art Unit	
	Zakiya N. Walker	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *26-37* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,12-21,24 and 25* is/are rejected.

7)☒ Claim(s) *10,11,22 and 23* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09232003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 12 (2nd occurrence) to 36 have been renumbered 13-37

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25, drawn to a method for treating/fracturing a zone, classified in class 166, subclass 308.2.

II. Claims 26-37, drawn to a treating fluid composition, classified in class 507, subclass 211.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Robert Kent on 6/30/05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3, 9, 15, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claims 3 and 15, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

11. Regarding claims 9 and 21, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Totten et al.

Totten et al. discloses a method that includes, with respect to independent claim 1, a method of treating a subterranean zone comprising the steps of: (a) preparing or providing a treating fluid comprising water containing divalent metal ions, a gelling agent, a borate crosslinking agent, and an environmentally benign sequestering agent

for sequestering divalent metal ions; and (b) introducing said treating fluid into said subterranean zone. With respect to the depending claims, the reference teaches the limitations as claimed, including hydroxypropylguar gelling agent, boric acid cross-linking agent, and sulfonic acid sequestering agent.

14. Claims 1-9, 12-21, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by McCabe et al. or Weaver et al. (cited by applicant).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

McCabe et al. discloses a method that includes, with respect to independent claims 1 and 13, a method of treating [fracturing] a subterranean zone comprising the steps of: (a) preparing or providing a treating [fracturing] fluid comprising water containing divalent metal ions, a gelling agent, a borate crosslinking agent, and an environmentally benign sequestering agent for sequestering divalent metal ions; and (b) introducing said treating [fracturing] fluid into said subterranean zone. With respect to the depending claims, the reference teaches the limitations as claimed, including hydroxypropylguar gelling agent, boric acid cross-linking agent, and sulfonic acid sequestering agent.

Weaver et al. discloses a method that includes, with respect to independent claims 1 and 13, a method of treating [fracturing] a subterranean zone comprising the steps of: (a) preparing or providing a treating [fracturing] fluid comprising water containing divalent metal ions, a gelling agent, a borate crosslinking agent, and an environmentally benign sequestering agent for sequestering divalent metal ions; and (b) introducing said treating [fracturing] fluid into said subterranean zone. With respect to the depending claims, the reference teaches the limitations as claimed, including hydroxypropylguar gelling agent, boric acid cross-linking agent, and sulfonic or phosphonic acid sequestering agent.

15. Claims 1-9, 12-21, 24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Dobson, Jr. et al.

Dobson, Jr. et al. discloses a method that includes, with respect to independent claims 1 and 13, a method of treating [fracturing] a subterranean zone comprising the steps of: (a) preparing or providing a treating [fracturing] fluid comprising water containing divalent metal ions, a gelling agent, a borate crosslinking agent, and an environmentally benign sequestering agent for sequestering divalent metal ions; and (b) introducing said treating [fracturing] fluid into said subterranean zone. With respect to the depending claims, the reference teaches the limitations as claimed, including hydroxypropylguar gelling agent, boric acid cross-linking agent, and sulfonic or carboxylic acid sequestering agent.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-3, 5-9, and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 7-12 of copending Application No. 10/664,206. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are merely a slightly broadened form of the US'206 application claims. Further, the applicant, as his own lexicographer, merely changed the name of the broad categories of compounds and substituted them with different broad names. The claims of the instant invention use different terms for the independent claim, but has the same scope as the earlier-filed US'206 application. For instance, the claims of the instant invention call for: a "gelling agent" as opposed to a "viscosity producing polymer"; a "borate crosslinking agent" as opposed to a "boron crosslinking agent"; and an "environmentally benign sequestering agent" as opposed to a "delayed crosslink

delinker" of the US'206 application. These terms represent identical compounds, and therefore do not change the scope of the invention. Therefore, it would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have used alternative language to describe the compounds of the composition in order to obtain broadened patent coverage.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

18. Claims 10, 11, 22, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zakiya N. Walker
Primary Examiner
Art Unit 3676

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July 1, 2005